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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PETER S. BROWN, MARCELYN A. BERLO, TINA A. TON, KIM-LIEN DANG, VERONICA CREECH, and JOANNE L. PARKER

Appeal 2008-3617
Application 10/760,129
Technology Center 1600

Decided: July 11, 2008

Before, DONALD E. ADAMS, DEMETRA J. MILLS, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

The following claim is representative.

1. A method of protecting a sensor attached to a graft intended to be delivered within vasculature using a catheter, comprising:
attaching a sensor to a graft;
attaching a marker to the graft;

folding portions of the graft to cover the sensor and the marker; and placing the graft within a catheter.

Cited References

Quiachon	US 5,749,920	May 12, 1998
Wolinsky	US 6,840,956	Jan. 11, 2005

Grounds of Rejection

1. Claims 1, 2, 4, 7, 8, and 28-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinsky in view of Quiachon.

DISCUSSION

Background

"This invention relates to the treatment of body lumens and, more particularly, to the endovascular placement of a prosthetic graft within vasculature for the purpose of repairing the same." (Spec. 1.) "In one aspect of the invention, a modular endovascular graft having a main body component and one or more limb components is provided. One or more sensors are attached to the limb component(s). (Spec. 5.)

The Examiner finds that:

> Wolinsky discloses a method of protecting a sensor attached to a graft (co1.5, lines 38-45) comprising attaching a sensor (12) to a graft (14), folding portions of the graft to cover the sensor (see either fig.3A or 3B) and placing the graft (14) within a catheter (32; co1.5, lines 38-59). Wolinsky discloses the use of markers (co1.6, lines 13-1 6), however is silent to mention the specific placement of markers. Quiachon teaches in the same field of vascular grafts, placement of a plurality of markers (197 shown placed along the length of the graft and diametrically opposed sides of the graft; fig.23,24) along the length of the

> graft (55) such that the graft may be detected during deployment (col. 14, lines 18-29).

(Ans. 3-4.)

> The Examiner concludes that:
>
> It would have been obvious to one having ordinary skill in the art at the time the invention was made, to combine Wolinsky's graft having a use of radiopaque markers, with Quiachon's teaching of exact placement of the markers directly onto the graft surface such that the graft may be detected during delivery. Wolinsky's graft having Quiachon's marker placement, inherently folds over the markers as well as the sensor since Wolinski's graft is folded several times, leaving less than 50%, more likely 1/3, of the graft exposed (non-covered), see figs.3a, 3b and co1.5, lines 38-48; and since Quiachon's markers are placed diametrically 180 degrees apart from one another, at least one line of markers inherently must be covered and protected (since they are 50% the distance of the graft circumference away from each other; and less than 50% of Wolinski's graft is exposed).

(Ans. 4.)

> Figure 3 of Wolinsy is reproduced below.

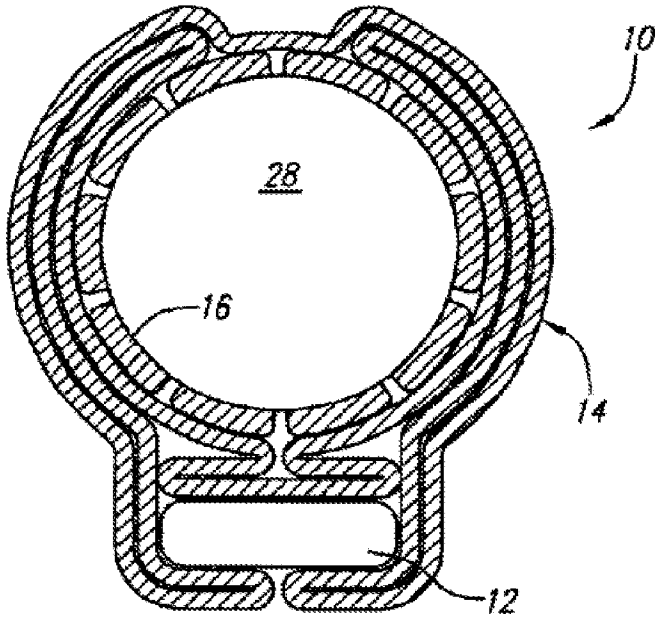

FIG. 3A

Figure 3 shows a graft stent 10 having a sensor 12.

Appellants contend that:

[I]t clear that it is not inherent that the markers of Wolinsky are covered by the folded over graft. The Office Action does not provide any further support for Wolinsky disclosing that the markers, even those disclosed by Quichon, are covered by folded portions of the graft. In fact, Quichon teaches away from the markers being positioned along an area that may be folded or otherwise folded over. Quichon explains at column 14, lines 46-53, that "[b]y placing markers of different lengths along the axis of the tubular member, it is possible to ascertain the position of the graft 55 and to determine whether the graft has twisted between its superior and inferior ends 171, 172. Under fluoroscopy, the two sets markers will be exhibited as two relatively straight lines for an untwisted graft, wherein a twisted graft will be revealed by a non-linear pattern of markers." (emphasis added). To position the markers at a position where they may be folded over or folded upon, may twist the markers and prevent the markers from being used to determine whether

> the graft has twisted. Quichon teaches against the combination proposed in the Office Action. Since Wolinsky and Quichon, even if combined, do not disclose every limitation of the claimed invention, but instead teach away from the claimed invention, a *prima facie* case of obviousness has not been established.

(Br. 11-12.)

Obviousness requires a teaching that all elements of the claimed invention are found in the prior art and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Furthermore, as stated in *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981): "Under the principles of inherency, if a prior art method, in its normal andusual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art." *See e.g. , In re King*, 801 F.2d 1324, 1326 (CAFC 1986). We do not find the Examiner's has provided sufficient evidence of record to establish a prima facie case of obviousness. In particular, we agree with Appellants that the Examiner has failed to identify the claimed folding portions of the graft which cover the markers. We further find that the Examiner has not provided sufficient evidence to support that the markers are inherently covered by the graft of Wolinsky as the markers in Quiachon are exposed on the outer portion of the graft. We do not find it inherent that the markers of Quiachon would necessarily be covered by a stent such as disclosed in Wolinsky.

We also find that the Examiner provides no reason for placement of the markers such that the markers will be folded with the sensors into the

graft as required by the claims. In view of the above the obviousness rejection is reversed.

SUMMARY

The obviousness rejection is reversed.

REVERSED

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